



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/942,699	08/31/2001	Akinori Iwase	016907-1275	9335
22428	7590	06/10/2005	EXAMINER	
FOLEY AND LARDNER			GOLD, AVI M	
SUITE 500			ART UNIT	PAPER NUMBER
3000 K STREET NW				
WASHINGTON, DC 20007			2157	

DATE MAILED: 06/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/942,699	IWASE ET AL.	
	Examiner	Art Unit	
	Avi Gold	2157	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 02 March 2005.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 14-28 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 14-28 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____

4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____

5) Notice of Informal Patent Application (PTO-152)

6) Other: _____

DETAILED ACTION

This action is responsive to the amendment filed on March 2, 2005. Claims 14-28 were added. Claims 1-13 were cancelled. Claims 14-28 are pending.

Response to Amendment

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 14-16, 19-21, and 24-26 are rejected under 35 U.S.C. 102(e) as being anticipated by Singhal, U.S. Patent No. 6,256,666.

Singhal teaches the invention as claimed including a method and system by which a user may use a low-capability device to direct a software agent to process and deliver large or complex documents embedded inside an electronic mail document (see abstract).

Regarding claim 14, Singhal teaches a server apparatus in which a groupware is operated, comprising:

an interface configured to transmit data to a mobile terminal (col. 4, lines 31-35, Singhal discloses a Mobile Access Gateway and Mobile Access Network); a database configured to manage separately data for transmission and data for storage among data addressed to the mobile terminal, the data for transmission being data to be transmitted to the mobile terminal, the data for storage being data not to be transmitted to the mobile terminal (col. 4, lines 57-63, Singhal discloses a filter within the Mobile Access Gateway which allows data for transmission to be sent and filters out the data for storage, i.e. attachments); and

a controller configured to store, in a predetermined storage location, the data for storage which is managed in the database, in response to a request for storage which is made by the mobile terminal after the mobile terminal receives the data for transmission, and to transmit the data for storage which is stored in the storage location to an external device, in response to a request for transfer which is made by the external device (col. 5, lines 8-25, 40-57, Singhal discloses the Attachment Control Message (ACM) working with the Mobile Message Processor (MMP) to store attachments and transmit stored data to a printer).

Regarding claims 15, 20, and 25, Singhal teaches the server apparatus and network system according to claims 14, 19, and 24, further comprising:

a second database configured to manage information indicating storage locations associated with respective mobile terminals (col. 5, lines 17-25, Singhal discloses the mobile Message Processor managing the ACMs which include storage locations),

wherein, in response to the request for storage which is made by the mobile terminal receiving the data for transmission, the controller stores the data for storage which is managed by the database, in the storage location which is associated with the mobile terminal receiving the data for transmission, and which is indicated by the information managed by the second database (col. 5, lines 8-25, 40-57).

Regarding claims 16, 21, and 26, Singhal teaches the server apparatus and network system according to claims 14, 19, and 24, wherein the external device is a printing device (col. 5, lines 40-53).

Regarding claim 19, Singhal teaches a network system comprising a first apparatus in which a groupware is operated, and a second apparatus connected to the first apparatus via a network, wherein the first apparatus comprises:

an interface configured to transmit data to a mobile terminal (col. 4, lines 31-35);
a database configured to manage separately data for transmission and data for storage among data addressed to the mobile terminal, the data for transmission being data to be transmitted to the mobile terminal, the data for storage being data not to be transmitted to the mobile terminal (col. 4, lines 57-63); and

a controller configured to transfer the data for storage which is managed in the database and an instruction for storing the data for storage to the second apparatus, in response to a request for storage which is made by the mobile terminal after the mobile terminal receives the data for transmission, and to transmit the data for storage which is

stored in the storage location to an external device, in response to a request for transfer which is made by the external device (col. 5, lines 8-25, 40-57), and

wherein the second apparatus comprises:

a memory configured to store the data for storage which is transferred from the first apparatus, when the memory receives the data for storage and the instruction for storing the data for storage (col. 5, lines 54-57, Singhal discloses an email server memory and storage related to the ACM and MMP); and

a controller configured to transmit the data for storage which is stored in the memory to an external device, in response to a request for transfer which is made by the external device (col. 5, lines 8-25, 40-57).

Regarding claim 24, Singhal teaches a server apparatus in which a groupware is operated, comprising:

an interface configured to transmit data to a mobile terminal (col. 4, lines 31-35);

a database configured to manage a text of electronic mail addressed to the mobile terminal as data for transmission which is to be transmitted to the mobile terminal, and a file attached to the electronic mail addressed to the mobile terminal as data for storage which is not to be transmitted to the mobile terminal (col. 4, lines 57-63); and

a controller configured to store, in a predetermined storage location, the file attached to the electronic mail which is managed in the database, in response to a request for storage which is made by the mobile terminal after the mobile terminal

receives the text of the electronic mail as the data for transmission, and to transmit the file attached to the electronic mail which is stored in the storage location to an external device, in response to a request for transfer which is made by the external device. (col. 5, lines 8-25, 40-57).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 17, 18, 22, 23, 27, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Singhal further in view of Sivula, U.S. Patent No. 6,795,711.

Singhal teaches the invention substantially as claimed including a method and system by which a user may use a low-capability device to direct a software agent to process and deliver large or complex documents embedded inside an electronic mail document (see abstract).

As to claims 17, 22, and 27, Singhal teaches the server apparatus and network system of claims 14, 19, and 24.

Singhal fails to teach the limitation further including the controller transmitting data after authentication processing indicates OK based on authentication data from the external device.

However, Sivula teaches adapting messaging content between different types of mobile terminal stations with minimal need for signaling (see abstract). Sivula teaches the use of data being transmitted to a mobile station after authentication (col. 6, line 34 – col. 7, line 7).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Singhal in view of Sivula to use authentication processing before transmitting data. One would be motivated to do so because it allows for the data to only be sent to whom it is meant for.

As to claims 18, 23, and 28, Singhal teaches the method of claim teaches the server apparatus and network system of claims 15, 20, and 25.

Singhal fails to teach the limitation further including a third database configured to manage a number of authentication data from the external device and the controller transmitting data after authentication.

However, Sivula teaches the use of special application service center keeping track of different directories for authentication and data being transmitted to a mobile station after authentication (col. 6, line 34 – col. 7, line 7).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Singhal in view of Sivula to use a third database configured to manage a number of authentication data from the external device and the controller transmitting data after authentication. One would be motivated to do so because it allows for the data to only be sent to whom it is meant for.

Response to Arguments

5. Applicant's arguments with respect to claims 14-28 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Pat. No. 6,714,133 to Hum et al.

U.S. Pat. No. 6,801,962 to Taniguchi et al.

Art Unit: 2157

U.S. Pat. No. 6,434,405 to Sashihara

U.S. Pat. No. 6,690,950 to Takagi et al.

U.S. Pat. No. 6,198,783 to Campana, Jr.

U.S. Pat. No. 6,782,419 to Tobita et al.

U.S. Pat. No. 6,304,898 to Shiigi

U.S. Pat. No. 6,157,945 to Balma et al.

U.S. Pat. No. 6,798,715 to Kubo et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Avi Gold whose telephone number is 571-272-4002. The examiner can normally be reached on M-F 8:00-5:30 (1st Friday Off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on 571-272-4001. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Avi Gold

Patent Examiner

Art Unit 2157

AMG


ARIO ETIENNE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100